



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,306	12/31/2001	Simon M. Furnish	12258-0032001	4514

26161 7590 12/04/2008
FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

SMITH, RUTH S

ART UNIT	PAPER NUMBER
----------	--------------

3737

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

12/04/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No. 10/037,306	Applicant(s) FURNISH, SIMON M.	
	Examiner Ruth S. Smith	Art Unit 3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 and 45-50 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33-38 and 41-48 is/are allowed.
- 6) ☒ Claim(s) 1,3,13,16,20,22-30,39,40,49 and 50 is/are rejected.
- 7) ☒ Claim(s) 2,4-12,14,15,17-19,21,31 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/13/08, 10/27/08</u> . | 6) <input type="checkbox"/> Other: _____ |

Specification

The disclosure is objected to because of the following informalities: In the amendment to the specification, filed 4/23/04, applicant cited the wrong serial number for the co-pending application. It appears that "10/037306" should be "10/037307". On page 22, line 5, "fiber 32" should be "fiber 44". On page 29, line 11 incorrectly refers to support strut 200. On page 31, line 6, "9a" should be "T9a". Appropriate correction is required.

Drawings

The drawings are objected to because Figure 1 fails to show reference numeral 12 as indicated on page 21 of the specification. In figure 1, box 15 should be labeled as to the element that it represents. Reference numerals alone are insufficient. In figure 5b, the lead line from reference numeral 120 is incorrectly directed toward element 128 (end cap). In figures 6a-d, reference numeral 166 is not shown as disclosed on page 27 of the specification. Figures 6a-d fail to show reference numeral 170 as disclosed. Reference numerals 194, 196 are not seen in figure 7 as disclosed. Beam L9 is not seen as disclosed.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the controlled analytical-light generating source and light collection analysis device must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

Art Unit: 3737

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 51 been renumbered claim 50.

Claims 6-8 are objected to because of the following informalities: In claim 6, the meaning of "for receipt of on the first and second..." is unclear. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,3,13,20,23-25,39-40,49,50 are rejected under 35 U.S.C. 102(e) as being anticipated by Zuluaga et al (US 2002/0183622).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The claims are directly readable on Zuluaga et al, particularly as seen in figures 10-12. Zuluaga et al disclose a catheter tip apparatus having an elongated rotatable housing (the elongated housing can be any part of rotary mounts 152,160 which are considered to be rotatably supported on the catheter sheath), a collection fiber 146, a delivery fiber 136, a light source 130, a light analysis device 50, reflective surfaces 132,134,142,144. The reflective surfaces can comprise a mirror (as seen in elements 138,150). The reflective surfaces are considered to be integral with the housing.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16,22,26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zuluaga et al. Zuluaga et al disclose a catheter tip apparatus having an elongated rotatable housing, a collection fiber 146, a delivery fiber 136, a light source 130, a light analysis device 50, reflective surfaces 132,134,142,144. The reflective surfaces can comprise a mirror. The reflective surfaces are considered to be integral with the housing. With respect to claim 22, the specific type of reflective surface used would have been an obvious design choice of known functional equivalents in the art. With respect to claims 16,27,30, in the absence of any showing of criticality, the manner in which the device is constructed would have been an obvious design choice of known equivalents in the art. With respect to claim 26, the use of an index matching material is an old and well known expedient in the optical art and would therefore have been obvious to one skilled in the art.

Allowable Subject Matter

Claims 33-38,41-48 are allowable over the prior art of record.

Claims 2,4,5,9-12,14,15,17-19,21,31-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 6-8 would be allowable if rewritten to overcome the objections set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed January 28,2008 have been fully considered but they are not persuasive. The apparatus disclosed by Zuluaga et al is considered to be a catheter tip apparatus in that it is an apparatus that includes a tip. The structure set forth in the claims does not require that the elements be present only in a tip portion of a catheter. The mount 152 is also considered to be part of an elongated housing that is rotatably supported on the catheter sheath. The apparatus of Zuluaga et al includes reflective surfaces which can include mirrors such as elements 150,138. The examiner pointed out some surfaces which are considered to be reflective surfaces such as the prisms but also indicated some surfaces which can be mirrors. The prisms themselves would be able to reflect a portion of the incoming light while refracting a portion of the light. The claims fail to define which end of the fibers are the distal ends, therefore the end of the fibers which are adjacent to the reflective surfaces are considered to be the distal end.

It should be noted that applicant failed to address many issues raised by the examiner in the previous office action such as the drawing informalities, the objection to the specification and the improper claim numbering.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S. Smith whose telephone number is 571-272-4745. The examiner can normally be reached on M-F 7:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ruth S. Smith/
Primary Examiner, Art Unit 3737

RSS